REMARKS

1. Status of the Claims

Claims 1-11 are pending. The claims were not amended.

2. Rejection Based on 35 U.S.C. § 103(a)

Claims 1-11 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Heitritter et al. (U.S. Patent No. 5,824,355) in view of Lanter et al. (U.S. Patent No. 5,540,932). Applicants respectfully disagree.

In the Office Action, Heitritter is cited for teaching all of the currently claimed method limitations, except for the addition of fat. Lanter is cited for teaching the addition of fat. The Office has not identified the motivation or teaching that would cause one of ordinary skill in the art to combine the cited references. The Office simply states "It would have been obvious to one of ordinary skill in the art...".

Further, the Lanter reference is directed towards an extruded animal feed. The presently claimed invention is not directed towards extruded feed; it is directed towards a method of making an animal feed.

Applicants submit that the office has failed to establish a *prima facie* case of obviousness. "In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143, eighth edition, revision 3, August 2005. Further, "[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of

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success must both be found in the art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP § 2143, eighth edition, revision 3, August 2005. Also, "[t]he level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999)." MPEP § 2143.01, eighth edition, revision 3, August 2005.

While "an express written motivation to combine" need not be present, Ruiz v. A.B. Chance Co., 357 F.3d 1270, 69 USPQ2d 1686 (Fed. Cir. 2004), failure to establish "the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention" caused the Federal Circuit to overturn "an obviousness rejection involving [a] technologically simple concept." In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000), as cited in MPEP § 2143.01 (IV), eighth edition, revision 3, August 2005.

Applicants submit that the Office has failed to establish the motivation or suggestion to combine the cited references. The Office has not established "the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention" (*Kotzab*, 55 USPQ2d at 1318.) as there is no discussion of this point in the office action. The Office merely asserts that the combination is "obvious." If the Office is aware of such a motivation or suggestion to combine the cited references, then it is requested to make the motivation or suggestion of record.

The Office has combined a "a process for manufacturing a high entergy protein protected ruminant feed" reference with a "fat" reference to derive the claimed invention. This is, at best, obvious to try, a rationale for establishing obviousness that has been repeatedly rejected by the courts. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596 (Fed Cir. 1988); In re O'Farrell, 853 F.2d 89, 7 U.S.P.Q.2d 1673 (Fed. Cir. 1988); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2s 1044, 1053, 5 U.S.P.Q.2d 1434 (Fed Cir. 1988). Applicants have thus

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established that the rejection under 35 U.S.C. § 103 based on the cited references is improper, and they request that it be withdrawn.

3. Double Patenting Rejection

Claims 1-11 stand rejected under the judicially created doctrine of obviousness type double patenting. In response, Applicants submit a duly executed terminal disclaimer herewith. As a result, they request that the double patenting rejection be withdrawn.

4. Statement of Common Ownership

Application number 10/611,576 (the instant application) and U.S. Patent No. 5,824,355 were, at the time the invention of Application 10/611,576 was made, owned by Ag Processing Inc.

Based on the above statement, Applicants respectfully submit that U.S. Patent No. 5,824,355 cannot be the basis for a rejection based on 35 U.S.C. § 103(a).

CONCLUSION

Applicants respectfully contend that all requirements of patentability have been met. Allowance of the claims and passage of the case to issue are therefore respectfully solicited.

Should the Examiner believe a discussion of this matter would be helpful, he is invited to telephone the undersigned at (312) 913-2114.

Respectfully submitted,

Date: July 14, 2006

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